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PATENT
03000-P0004C WWW/SBS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application Of	
Wesley W. Whitmyer, Jr.	Examiner: Nguyen, Cindy
Serial No.: 09/725,394	Group Art Unit: 2171
Filed: November 29, 2000	Confirmation No. 9725
For: Web Site Automating Transfer Of Intellectual Property	

Substitute Appeal Brief Under 37 C.F.R. §41.37

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Having filed herewith a Notice of Appeal from the final rejection of Claims 1-10, all of the claims currently pending, the final rejection being mailed on May 22, 2006, Appellant submits its Appeal Brief for the above-captioned application pursuant to 37 C.F.R. §41.37.

Certificate of Mailing: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: : Mail Stop Appeal Brief – Patents; Commissioner for Patents; P.O. Box 1450; Alexandria, VA 22313-1450.

August 21, 2006 Ellise Kuban
Ellise J. Kuban

(I) Real Party in Interest

The real party in interest is Wesley W. Whitmyer, Jr.; 72 Fernwood Drive, Stamford, CT 06903.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status Of Claims

Claims 1-10 are currently pending. Claims 1-10 stand rejected and are the subject of the instant Appeal.

IV. Status Of Amendments

Subsequent to the Final Rejection being mailed on May 22, 2006, Appellant has filed no Amendments.

V. Summary Of Claimed Subject Matter

Claim 1

Claim 1 is directed toward a system for automating the recordation of a property transfer (p. 1, lns. 6-9; p. 3, lns. 1-4.) The system comprises an Internet server (p. 4, lns. 3-11; p. 7, lns. 3-11; FIGS. 1 & 2), and a communications link

between the Internet server and the Internet (p. 4, lns. 3-6; p. 7, lns. 4 & 21; p. 8, ln. 28; p. 10, lns. 4-5; FIGS. 1 & 2.) The system further comprises at least one database containing a plurality of information records accessible by the Internet server, each information record including an intellectual property identification number (p. 4, ln. 18-20; p. 7, lns. 5-7 & 22-25; p. 8, lns. 29-31; p. 10, lns. 6-9; FIGS. 1 & 2.) The system still further comprises at least one database containing a plurality of recordation forms accessible by the Internet server (p. 4, lns. 16-18; p. 7, lns. 8-9 & 26-29, p. 9, lns. 2-5; p. 10, lns. 9-10; FIGS. 1 & 2), and software executing on the Internet server for receiving a transfer request indicative of a transfer of rights to the property (p. 4, lns. 13-16; p. 7, ln. 10; p. 9, ln. 6; p. 10, ln. 11.) The system also includes software executing on the Internet server for querying the database of information records to retrieve an information record corresponding to a transfer request, for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a document (p. 4, lns. 16-22; p. 7, lns. 11-16; p. 8, lns. 6-12; p. 9, lns. 7-13; p. 10, ln. 12; FIG. 1.)

Claim 3

Claim 3 is directed toward a system for automating the recordation of a property transfer (p. 1, lns. 6-9; p. 3, lns. 1-4.) The system comprises an Internet server (p. 4, lns. 3-11; p. 7, lns. 3-11; FIGS. 1 & 2), and a communications link between the Internet server and the Internet (p. 4, lns. 3-6; p. 7, lns. 4 & 21; p. 8, ln. 28; p. 10, lns. 4-5; FIGS. 1 & 2.) The system further comprises at least one database containing a plurality of information records accessible by the Internet server, each information record including an intellectual property identification

number, an intellectual property type identifier, and a jurisdiction identifier (p. 4, ln. 18-20; p. 7, lns. 5-7 & 22-25; p. 8, lns. 29-31; p. 10, lns. 6-9; FIGS. 1 & 2.) The system still further comprises at least one database containing a plurality of recordation forms accessible by the Internet server, each recordation form including an intellectual property type identifier and a jurisdiction identifier (p. 4, lns. 16-18; p. 7, lns. 8-9 & 26-29, p. 9, lns. 2-5; p. 10, lns. 9-10; FIGS. 1 & 2.) The system also includes software executing on said Internet server for generating a property transfer request form indicative of a transfer of rights to the property (p. 4, lns. 13-15; p. 7, ln. 30 – p. 8, ln. 1), software executing on said Internet server for transmitting said property transfer request form through the Internet (p. 4, lns. 13-15; p. 8 lns. 2-3; p. 9, lns. 14-15; FIG. 1), and software executing on said Internet server for receiving a reply to said property transfer request form (p. 4, lns. 16-18; p. 8, lns. 4-5; p. 9, lns. 20-21.) The system further includes software executing on the Internet server for querying the database of information records to retrieve an information record corresponding to the property transfer request, for querying said database of recordation forms to retrieve a recordation form corresponding to the property transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a transfer document (p. 4, lns. 16-22; p. 7, lns. 11-16; p. 8, lns. 6-12; p. 9, lns. 7-13; p. 10, ln. 12; FIG. 1.) In addition, the system comprises software executing on the Internet server for transmitting the transfer document through the Internet (p. 4, lns. 23-25; p. 8, lns. 13-14; p. 9, lns. 14-15; p. 10, ln. 12) and software executing on said Internet server for receiving the transfer document though the Internet (p. 4, ln. 28 – p. 5, ln. 3; p. 8, lns. 15-16; p. 10, ln. 13.)

Claim 8

Claim 8 is directed toward a system for automating the recordation of a property transfer (p. 1, lns. 6-9; p. 3, lns. 1-4.) The system comprises an Internet server (p. 4, lns. 3-11; p. 7, lns. 3-11; FIGS. 1 & 2), a communications link between the Internet server and the Internet (p. 4, lns. 3-6; p. 7, lns. 4 & 21; p. 8, ln. 28; p. 10, lns. 4-5; FIGS. 1 & 2), and at least one database containing a plurality of information records accessible by the Internet server, each information record including an intellectual property identification number, an intellectual property type identifier, and a jurisdiction identifier (p. 4, ln. 18-20; p. 7, lns. 5-7 & 22-25; p. 8, lns. 29-31; p. 10, lns. 6-9; FIGS. 1 & 2.) The system still further comprises at least one database containing a plurality of recordation forms accessible by the Internet server, each recordation form including an intellectual property type identifier and a jurisdiction identifier (p. 4, lns. 16-18; p. 7, lns. 8-9 & 26-29, p. 9, lns. 2-5; p. 10, lns. 9-10; FIGS. 1 & 2), and software executing on the Internet server for receiving a transfer request indicative of a transfer of rights to the property (p. 4, lns. 13-16; p. 7, ln. 10; p. 9, ln. 6; p. 10, ln. 11.) The system further includes software executing on the Internet server for querying the database of information records to retrieve an information record corresponding to a transfer request, for querying the database of recordation forms to retrieve a recordation form corresponding to the transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a transfer document (p. 4, lns. 16-22; p. 7, lns. 11-16; p. 8, lns. 6-12; p. 9, lns. 7-13; p. 10, ln. 12; FIG. 1.) In addition, the system comprises software executing on the Internet server for transferring the transfer document through the Internet (p. 4, lns. 13-15; p. 8 lns. 2-3; p. 9, lns. 14-15; FIG. 1), software executing on the Internet server for generating a property information request form (p. 5, lns. 12-13; p. 6, lns. 1-5; p. 9, lns. 16-17), and software executing on the Internet server for

transmitting the property information request form through the internet (p. 5, lns. 12-13; p. 6, ln. 4; p. 9, lns. 18-19.) Finally, the system includes software executing on the Internet server for receiving a reply to the property transfer request form (p. 4, lns. 16-18; p. 8, lns. 4-5; p. 9, lns. 20-21), software executing on the Internet server for querying the database of information records to retrieve information records corresponding to the intellectual property information request (p. 5, lns. 15-16; p. 6, lns. 6-8; p. 9, lns. 22-24), and software executing on the Internet server for updating the database containing a plurality of information records (p. 5, lns. 23-26; p. 9, lns. 25-26.)

VI. Grounds Of Rejection To Be Reviewed On Appeal

(1) Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,987,464 (hereinafter "Schneider") in view of U.S. Patent No. 6,766,305 (hereinafter "Fucarile").

(A) Whether the Examiner's rejection under 35 U.S.C. § 103(a) is proper despite the fact that neither Schneider nor Fucarile teach, disclose or suggest software executing on the Internet server for querying the database of information records to retrieve an information record corresponding to a transfer request, for querying the database of recordation forms to retrieve a recordation form corresponding to the transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a transfer document as required by all of the Claims.

(B) Whether the Examiner's rejection under 35 U.S.C. § 103(a) is proper despite the fact that neither Schneider nor Fucarile teach, disclose or

suggest software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property as required by Claims 1 and 8.

(C) Whether the Examiner's rejection under 35 U.S.C. § 103(a) is proper despite the fact that neither Schneider nor Fucarile teach, disclose or suggest software executing on the Internet server for generating a property transfer request form indicative of a transfer of rights to the property as required by Claim 3.

(D) Whether the Examiner's rejection under 35 U.S.C. § 103(a) is proper despite the fact that there is no motivation to combine Schneider with Fucarile.

VII. Argument

(1) Rejection of Claims 1 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Schneider in view of Fucarile

(A) Neither Schneider nor Fucarile teach, disclose or suggest software executing on the Internet server for querying the database of information records to retrieve an information record corresponding to a transfer request, for querying the database of recordation forms to retrieve a recordation form corresponding to the transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a transfer document

The present application is directed toward a system for the transfer of intellectual property rights such as, patents, trademarks and copyrights. To legally transfer these types of intellectual property, specific transfer forms must be filed with, for instance, the United States Patent and Trademark Office. A database containing a plurality of recordation forms may include for instance, any of these standardized forms required to be filed with the United States Patent and Trademark Office. The system can then retrieve data from a database that is specific to an intellectual property and then combine this information with a selected transfer form, which is selected according to the intellectual property to be transferred, to generate a transfer document.

Alternatively, the system claimed in the present application analyzes a property transfer request by a user, selects the proper transfer form from a database of generic recordation forms, and generates a property transfer document based upon combining a retrieved information record with a retrieved recordation form. The claims of the present application require two databases of information, one containing a plurality of information records (i.e. specific information relating to an intellectual property), and the other containing a plurality of generic recordation forms (i.e. standardized forms for transferring intellectual property). All the claims of the present application further require combining the retrieved information record (the specific information relating to the intellectual property) with the retrieved generic recordation form (the standardized form for transferring the intellectual property) to generate a document.

The Examiner has submitted that while Schneider does not disclose software that performs this function, that Fucarile does citing col. 8, line 62 through col. 9, line 42. (See, Official Action 5/22/06, p. 5.) Appellant disagrees.

Fucarile teaches that a "user computer 100 sends requests 401 over the network to the content server 200 for content 201" and that the "content server 200 sends responses 402 back to the user computer containing the requested content 201" and that a "plug-in 103 running on the user computer 100 ultimately receives this content 201." (col. 8, line 64 – col. 9, line 2.) Fucarile goes on to disclose that "the plug-in 103 on user computer 100 scans the content 201 for the {License . . . } form prior to actual execution or interpretation of the content" and that the License is then sent to an "authorization server 403" generates a response to allow access to the content. (*See*, col. 9, lines 3-5 & 20-22.) However, nowhere does Fucarile teach, disclose or suggest the use of a database of recordation forms or that an information record corresponding to a transfer request is combined with a recordation form to generate a transfer document.

Fucarile teaches that a license form may be used, or alternatively, that an assertion of non-commercial use may be sent to the user, either of which must be sent to an Authorization server in order for the user to access the content. In contrast, the present system includes a database for forms that are to be filed with the U.S. Patent and Trademark Office for the legal transfer of property, such as patents, trademarks and copyrights. Nowhere does Fucarile teach combining the retrieved information record with the retrieved recordation form to generate a transfer document. The transfer document that is generated by the present system is a combination of the information record relating to the property to be transferred, e.g. patent number, date of issuance, serial number, assignor, etc., which is merged into a recordation form, e.g. a specific form acceptable to the U.S. Patent and Trademark Office for transfer of title to the property, to form the

transfer document. Fucarile simply fails to teach or suggest the formation of any such documentation.

Appellant submits that the Examiner has stated that Schneider also fails to teach or suggest this limitation. In fact, Applicant submits that Schneider teaches "a system and method for updating patent files of a computer and/or computer system so that the patent files will include newly issued patent and premature expired ones." (col. 4, lines 54-57.) Schneider goes on to teach that "the present invention provides a portable storage media . . . that is being used to install a program, reference data files or other data to a computer or computer system." (col. 4, lines 62-62.) Accordingly, Schneider has nothing to do with the transfer of property rights, rather, it is directed toward a system for updating a database of information, which may include patents and information related to patents.

Accordingly, Appellant submits that because neither Fucarile nor Schneider teach or suggest software executing on the Internet server for querying the database of information records to retrieve an information record corresponding to a transfer request, for querying the database of recordation forms to retrieve a recordation form corresponding to the transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a transfer document as required by all of the pending claims, no combination thereof can render the pending claims obvious.

(B) Neither Schneider nor Fucarile teach, disclose or suggest software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property as required by Claims 1 and 8

The Examiner has submitted that "Schneider discloses . . . software executing on said Internet server for receiving a transfer request indicative of a transfer of right to the property (column 15, line 52 – column 16, line 33)." (Official Action 5/22/06, pp. 4-5.) Appellant disagrees. Schneider teaches "a system and method for updating patent files of a computer and/or computer system so that the patent files will include newly issued patent and premature expired ones." (col. 4, lines 54-57.) Therefore, Schneider is directed toward a system for updating a database of information, which may include patents and information related to patents. The portion of the specification the Examiner cited as teaching "a transfer request indicative of a transfer of right to the property" teaches the process of querying the database over an Internet connection for information relating to patent, such as "premature expirations that have entered into the public domain." (*See*, col. 15, lines 52-54; col. 16, lines 3-9.) Nowhere does Schneider even hint at transferring property rights, rather, Schneider is directed to a system for searching and updating a database of information relating to patents, in particular, updating which patents have newly issued and/or prematurely expired. (*See*, col. 4, lines 54-57.)

Appellant submits that the Examiner has not asserted that Fucarile teaches or suggests this limitation. Appellant further submits that Fucarile is directed toward a system for disseminating licensed content and has nothing to do with transferring ownership of, for example, intellectual property.

Accordingly, Appellant submits that because neither Schneider nor Fucarile teach or suggest software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property as required by Claims 1 and 8, no combination thereof can render these claims obvious.

(C) Neither Schneider nor Fucarile teach, disclose or suggest software executing on the Internet server for generating a property transfer request form indicative of a transfer of rights to the property as required by Claim 3

As stated above, Schneider is directed toward a system for updating a database of information, which may include patents and information related to patents. Nowhere does Schneider teach or suggest generation of a property transfer request form indicative of a transfer of right to a property.

Additionally, Fucarile is directed to a system for disseminating licensed content. While Fucarile discloses that the "user computer 100 sends requests 401 over the network to the content server 200 for content 200" nowhere does Fucarile teach or suggest that a property transfer request form is generated. (col. 8, lines 64-66.) Fucarile is simply not directed toward a system for transferring ownership of, e.g. a patent or trademark or copyright, and therefore there is no need to generate a formal "property transfer request form" as recited in claim 3.

Accordingly, Appellant submits that because neither Schneider nor Fucarile teach or suggest software executing on the Internet server for generating a property transfer request form indicative of a transfer of rights to the property as required by Claim 3, no combination thereof can render claim 3 obvious.

(D) There is no motivation to combine Schneider with Fucarile

The Examiner has submitted that "it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of Fucarile with the teachings of Schneider to enable the system which

can be adapted to hold license records (recordation form) and receive and store access information such as number of accesses, user information and the license server can then generate usage reports that can be used to determine licensing requirements." (Official Action 5/22/06, pp. 3-4.) Applicant cannot see how the above-stated motivation is either related to either Schneider or Fucarile or to the pending claims.

It is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See, e.g.,* MPEP 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."); *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (fact that prior art "may be capable of being modified to run the way the apparatus is claimed, there must be some suggestion or motivation in the reference to do so."). In the present case, Applicant respectfully submits that Schneider is directed to an updating system for updating various fields of information relating to, for example, patents; while Fucarile is related to providing licensing of requested content. There is no suggestion in either reference that it would be advantageous to generate usage reports for users accessing the patent information taught in Schneider. In fact, Schneider teaches that a database of information is installed on the user computer, which works off-line, but that the database can be updated according to the description in the specification. (*See*, col. 4, line 62 – col. 5, line 9.)

The Federal Circuit has stated that "[w]e do not pick and choose among the individual elements of assorted prior art reference to recreate the claimed

invention" but rather, we look for "some teaching or suggestion in the references to support their use in a particular claimed combination." *Symbol Technologies, Inc, v. Opticon, Inc.*, 935 F.2d 1569, 1576 (Fed. Cir. 1991). The Federal Circuit has also stated that "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself." *In re Oetiker*, 977 F.2d, 1443, 1447 (Fed. Cir. 1992). *See also In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (suggestion to combine must be found in the prior art, not the applicant's disclosure). In this case, neither reference is directed toward a system that combines an information record with a recordation form to generate a transfer document. In fact, Schneider has nothing to do with the transfer of any type of right. Rather, it appears that the Examiner is using the presently pending claims as a roadmap to pick and choose individual elements from none-related references to formulate an obvious rejection.

Accordingly, Appellant submits that there is no motivation to combine Schneider with Fucarile as suggested by the Examiner, and even if one were to combine the references as suggested, one would not arrive at the presently claimed invention.

Conclusion

For the foregoing reasons, Applicant respectfully submits that the claimed invention embodied in each of Claims 1-10 is patentable over the cited prior art. As such, Applicant respectfully requests that the rejections of each of Claims 1-10 be reversed and the Examiner be directed to issue a Notice of Allowance allowing each of Claims 1-10.

Respectfully submitted,

August 17, 2006

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(VIII) Claims Appendix

1. (previously presented) A system for automating the recordation of a property transfer comprising:

an Internet server;

a communications link between said Internet server and the Internet;

at least one database containing a plurality of information records accessible by said Internet server, each information record including an intellectual property identification number;

at least one database containing a plurality of recordation forms accessible by said Internet server;

software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property; and

software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request, for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a document.

2. (original) The system of claim 1 wherein said property is intellectual property such as patents, copyrights, and trademarks.

3. (previously presented) A system for automating the recordation of a property transfer comprising:

an Internet server;

a communications link between said Internet server and the Internet;

at least one database containing a plurality of information records accessible by said Internet server, each information record including an intellectual property identification number, an intellectual property type identifier, and a jurisdiction identifier;

at least one database containing a plurality of recordation forms accessible by said Internet server, each recordation form including an intellectual property type identifier and a jurisdiction identifier;

software executing on said Internet server for generating a property transfer request form indicative of a transfer of rights to the property;

software executing on said Internet server for transmitting said property transfer request form through the Internet;

software executing on said Internet server for receiving a reply to said property transfer request form;

software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to said property transfer request, for querying said database of recordation forms to retrieve a recordation form corresponding to said property transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a transfer document;

software executing on said Internet server for transmitting said transfer document through the Internet; and

software executing on said Internet server for receiving said transfer document though the Internet.

4. (original) The system of claim 3 wherein said property is intellectual property such as patents, copyrights, and trademarks.

5. (original) The system of claim 3 further comprising of software executing on said Internet server for receiving an executed transfer document.

6. (original) The system of claim 3 further comprising of software executing on said Internet server for transmitting an executed transfer document.

7. (original) The system of claim 3 further comprising of software executing on said Internet server for transmitting said executed transfer document to a property recordation authority.

8. (previously presented) A system for automating the recordation of a property transfer comprising:

an Internet server;

a communications link between said Internet server and the Internet;

at least one database containing a plurality of information records accessible by said Internet server, each information record including an intellectual property identification number, an intellectual property type identifier, and a jurisdiction identifier;

at least one database containing a plurality of recordation forms accessible by said Internet server, each recordation form including an intellectual property type identifier and a jurisdiction identifier;

software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property;

software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request, for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a transfer document;

software executing on said Internet server for transferring said transfer document through the Internet;

software executing on said Internet server for generating a property information request form;

software executing on said Internet server for transmitting said property information request form through the internet;

software executing on said Internet server for receiving a reply to said property transfer request form;

software executing on said Internet server for querying said database of information records to retrieve information records corresponding to said intellectual property information request; and

software executing on said Internet server for updating said database containing a plurality of information records.

9. (original) The system of claim 8 wherein said property is intellectual property such as patents, copyrights, and trademarks.

10. (original) The system of claim 8 further comprising of software executing on said Internet server for retrieving said updates to said database containing a plurality of in-formation records through the Internet from a plurality of sources.

(IX) Evidence Appendix

There is no evidence submitted under 37 CFR 1.130, 1.131 or 1.132 or any other evidence entered by the examiner and relied upon by the appellant in the appeal.

(X) Related Proceedings Appendix

There are no decisions or pending related appeals and interferences per 37 CFR 41.37 (c)(1)(x).